



UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/286,043 04/05/99 SCHNEITER

A 1634.001

023405 TM02/0906  
HESLIN ROTHENBERG FARLEY & MESITI PC  
5 COLUMBIA CIRCLE  
ALBANY NY 12203

EXAMINER

COLBERT, E

ART UNIT

PAPER NUMBER

2172

DATE MAILED:

09/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Reply Brief

DOCKETED 11/6/01

BOA Decision

DOCKETED 9/6/02





UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
[www.uspto.gov](http://www.uspto.gov)

**MAILED**  
SEP 6 - 2001  
Technology Center 2100

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 12

Application Number: 09/286,043  
Filing Date: April 05, 1999  
Appellant(s): SCHNEITER ET AL.

Reinke, Wayne F., Reg. No. 36,650

For Appellants'

**EXAMINER'S ANSWER**

This is in response to appellant's brief on appeal filed June 26, 2001.

Art Unit: 2172

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 1-48 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Art Unit: 2172

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,778,368	Hogan et al	07/07/98
-----------	-------------	----------

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-48 are rejected under 35 U.S.C. 102 (a) as being anticipated by Hogan et al. (USPN 5,778,368), hereafter Hogan.

**Regarding claim 1:**

Each and every element of claim 1 is disclosed by Hogan, note: the claimed “requesting from a first computer to a second computer remote from the first computer in the distributed computer system to search information of at least one entity” is shown in col. 9, lines 14-36,

the claimed “indicating from the first computer to search agent associated with the second computer to at least one search criterion for the information of the at least one entity” is shown in col. 14, lines 25-33,

Art Unit: 2172

the claimed “accessing by the search agent at least one database remote from the first computer and the second computer in the distributed computer system” is shown in col. 9, lines 14-36,

the claimed “at least one database comprises information of a plurality of entities including the at least one entity, and wherein the at least one entity comprises less than all the plurality of entities” is shown in col. 11, lines 37-61,

the claimed “performing by the search agent a search based on the at least one search criterion on only the information of the at least one entity in the at least one database” is shown in col. 11, lines 37-61 & col. 14, lines 25-33.

**Regarding claim 2:**

The claimed “providing results of the search to the search agent” is shown in col. 11, lines 37-61.

**Regarding claim 3:**

Claim 3 is rejected for the similar rationale given for claim 2.

**Regarding claim 4:**

The claimed “the search agent is transferred from the second computer to the first computer and runs at the first computer, wherein a communication agent also resides at the first computer, the communication agent performing the requesting and the indicating, and wherein the search agent provides the results of the search to the communication agent” is shown in col. 4, lines 10-65.

Art Unit: 2172

**Regarding claim 5:**

The claimed “at least one database is stored at least one third computer remote from the first computer and the second computer in the distributed computer system, and wherein the search agent resides at the at least one third computer” is shown in col. 11, lines 1-13.

**Regarding claim 6:**

Claim 6 is rejected for the similar rationale given for claim 5.

**Regarding claim 7:**

Claim 7 is rejected for the similar rationale given for claim 5.

**Regarding claim 8:**

The claimed “the first computer is associated with a buyer, wherein the second computer is associated with a seller, wherein the at least one entity comprises the seller, and wherein the information comprises product and/or service information of the seller” is shown in col. 5, lines 58 to col. 6, lines 26.

**Regarding claim 9:**

Claim 9 is rejected for the similar rationale given for claim 5.

**Regarding claim 10:**

Claim 10 is rejected for the similar rationale given for claim 1.

**Regarding claim 11:**

Claim 11 is rejected for the similar rationale given for claim 1.

**Regarding claim 12:**

Art Unit: 2172

Claim 12 is rejected for the similar rationale given for claims 1, 4, 8.

**Regarding claim 13:**

Claim 13 is rejected for the similar rationale given for claim 5.

**Regarding claim 14:**

Claim 14 is rejected for the similar rationale given for claim 5.

**Regarding claim 15:**

Claim 15 is rejected for the similar rationale given for claim 5.

**Regarding claim 16:**

The claimed “at least one search criterion comprises a null criterion such that the search returns all information of the at least one entity in the at least one database” is shown in col. 4, lines 20-34.

**Regarding claims 17-33:**

Claims 17-33 are rejected for the similar rationale given for claims 1-16.

Regarding claims 34-46:

**Regarding claims 34-46:**

Claims 34-46 are rejected for the similar rationale given for claims 1-16.

**Regarding claim 47:**

Claim 47 is rejected for the similar rationale given for claim 1.

**Regarding claim 48:**

Claim 48 is rejected for the similar rationale given for claim 1.

Art Unit: 2172

**(11) Examiner's Response to Arguments:**

Prior to providing individual responses to each of the arguments, the Examiner notes the following: The invention as claimed in each of the pending claims is directed to database searches on a portion of a remote database in a distributed computer system.

The Hogan et al. reference applied teaches database searches on a portion of a remote database in a distributed computer system. The Hogan et al. reference is classified in class 707, subclass 10, of the U.S. Patent classification system, one of the most relevant areas of search for database searches on a portion of a remote database in a distributed computer system to which the invention is directed.

For all of the issues please refer to the final rejections.

The following arguments are relevant:

In response to Appellants' arguments no. 1, page 5, paragraph 2: Reading both the at least one entity and the at least one database of claim 1 on the Hogan et al. repository database results in several shortcomings. First, doing so renders the performing step of claim 1 meaningless, second, it would render both clauses in the accessing step meaningless, and third, Appellants' could find no overt statement to this effect, Hogan et al. appears to house the repository database within the repository servers in col. 11, lines 55-60 of Hogan et al. using "Repository Servers" and "Repository database" interchangeably. The Appellants' are mischaracterizing their own citation in this argument. The Appellants' are misinterpreting the cited col. 11, lines 55-60 of the Hogan et al. reference. The columns and line numbers cited



Art Unit: 2172

by the Examiner are col. 11, lines 37-61 and this col. and line numbers recite “.. All Repository Servers in the network system have rules that allow them to access and search any other Repository database or deny access to the search as required. The Repository databases may also be encrypted so that the Repository Clients are denied access to the Repository databases via encryption or password identifiers.” The Examiner does not interpret this col. and these line numbers as using “Repository servers” and “Repository database” interchangeably.

In response to Appellants’ argument no. 2, page 5, paragraph 3:

Claim 1 cannot logically be read on Hogan et al. where the Hogan et al. repository database is cited as both the at least one entity and the at least one database of claim 1. The “entity” is intended to be just that; ... the entity is a business according to the specification and was never intended to be a database which was borne out of incompatibilities resulting from an attempt to read the entity on a database. Appellants’ argument is a contradiction of the interpretation according to Appellants’ arguments in no. 1.

In response to Appellants’ argument no. 3, page 6, paragraph 4:

The section of Hogan et al. cited in the Final Office Action for claim 4 contains objects of the invention, and has no disclosure regarding a transfer of the search agent from the server to the client. In response to Appellants’ argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., a transfer of the search agent from the server to the client) are not recited in the rejected claim(s) 4.

Art Unit: 2172

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claim 4 recites “the search agent is transferred from the second computer to the first computer and runs at the first computer, wherein a communication agent also resides at the first computer, the communication agent performing the requesting and the indicating, and wherein the search agent provides the results of the search to the communication agent.”

In response to Appellants’ argument no. 4, page 7, paragraph 2:

Appellants’ submit that the cited section of Hogan et al. In claim 5 contains no disclosure regarding the database being separate from the repository server. Appellants’ submit that Hogan et al. discloses the repository database being housed within the repository server, for example, Hogan et al. at col. 11, lines 55-60, in which “repository servers” is used interchangeably with “repository database.” This argument has been discussed above in argument no. 1.

In response to Appellants’ argument no. 5, page 8, paragraph 1:

There is nothing in the cited section regarding a seller and a buyer, or that the information in the database is anything other than the repository units themselves (perhaps annotated), whereas claim 8 recites product and/or service information of the seller, and not the products/services themselves. Hogan et al. teaches in col. 6, specifically lines 9-10 and lines 15-27 that the information in the database regards a seller and a buyer. This column and line

Art Unit: 2172

numbers recite "... access to the contents of a Repository database," "... the Attributes that are applicable and meaningful to other organizations within a company, for example information such as cost, value, and related technology ... " ( sellers) and " ... the present invention includes capabilities that are applicable to an entire range of users from marketing, to business development, to accounting, among others" (buyers).

In response to Appellants' argument no. 6, page 8, paragraph 4:

Claim 12 is directed to something different than in Hogan et al. because the "format" of claim 12 refers to the look and feel of the Web site. Appellants' claim 12 does not recite anything in the claim language relating to the look and feel of the Web site. Appellants' claim 12 recites "wherein the second computer provides access to a Web site of the at least one entity having a particular format, the method further comprising providing results of the search to the second computer in a format compatible with the particular format, enabling the second computer to provide a consistent experience on the Web site to a user of the first computer. Claim limitations are not read into Appellants' claims by the Examiner.

In response to Appellants' argument no. 7, page 9, paragraph 1:

Appellants' submit that there is no disclosure in the cited section of Hogan et al. in claim 15 regarding maintenance of the repository database, let alone maintenance by the at least one entity. Hogan et al teaches, maintenance by the at least one entity in col. 6, lines 1-7. This column and line numbers recite " ... thereby allows a software engineer to fully characterize a real-time embedded software module, software sub-system or software system in a manner that

Art Unit: 2172

facilitates its re-use as well as achieves visibility of the software module. The software module, software sub-system can provide added value to an entire organization" (maintenance of the at least one entity).


For the above reasons, it is believed that the rejections should be sustained.


  
E. Colbert

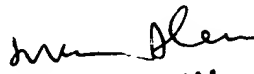
September 1, 2001

Wayne F. Reinke  
Heslin & Rothenberg, P.C.  
5 Columbia Circle  
Albany, New York 12203-5160

Conferees:

(1) Primary Examiner  
Wayne Amsbury 

(2) Primary Examiner   
Hosain Alam

  
HOSAIN T. ALAM  
PRIMARY EXAMINER

**Attachment for PTO-948 (Rev. 03/01, or earlier)**  
**6/18/01**

**The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.**

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.